

MELODY A. KRAMER, SBN 169984  
KRAMER LAW OFFICE, INC.  
9930 Mesa Rim Road, Suite 1600  
San Diego, California 92121  
Telephone (858) 362-3150  
mak@kramerlawip.com

J. MICHAEL KALER, SBN 158296  
KALER LAW OFFICES  
9930 Mesa Rim Road, Suite 200  
San Diego, California 92121  
Telephone (858) 362-3151  
michael@kalerlaw.com

Attorneys for Plaintiff JENS ERIK SORENSEN,  
as Trustee of SORENSEN RESEARCH AND  
DEVELOPMENT TRUST

UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF CALIFORNIA

JENS ERIK SORENSEN, as Trustee of	)	Case No. 08 CV 304 BTM CAB
SORENSEN RESEARCH AND	)	
DEVELOPMENT TRUST,	)	<b>DECLARATION OF MELODY A.</b>
	)	<b>KRAMER IN SUPPORT OF</b>
Plaintiff	)	<b>OPPOSITION TO MOTION TO</b>
v.	)	<b>STAY THE LITIGATION PENDING</b>
	)	<b>THE REEXAMINATIONS OF U.S.</b>
METABO CORPORATION, a Delaware	)	<b>PATENT NO. 4,935,184</b>
Corporation; METABOWERKE GMBH,	)	
a German Corporation; and DOES 1 –	)	
100,	)	
	)	
Defendants.	)	

1 I, MELODY A. KRAMER, declare:

2 1. I am not a party to the present action. I am over the age of eighteen. I  
3 have personal knowledge of the facts contained within the following paragraphs, and  
4 could and would competently testify thereto if called as a witness in a court of law.

5 2. At all times relevant herein I have been an attorney for Sorensen  
6 Research and Development Trust ("Sorensen"), Plaintiff in the above-captioned  
7 matter.

8 3. This declaration is made in support of Plaintiff's Opposition to Motion  
9 to Stay the Litigation Pending the Reexaminations of U.S. Patent No. 4,935,184.

10 4. In July 2007, a non-party to this case, Black & Decker, filed a request  
11 for reexamination of U.S. Patent 4,935,184 ("184 patent") ("1<sup>st</sup> reexam"). As with  
12 96% of all such requests, the 1<sup>st</sup> reexam request was granted (see Exhibit A). In  
13 December 2007, co-defendants to Black & Decker filed another request for  
14 reexamination of the '184 patent ("2<sup>nd</sup> reexam") which was also granted.

15 5. Only 10 percent of all reexamination requests granted by the PTO result  
16 in cancellation of all claims of a patent. Exhibit B attached hereto is a true and  
17 correct copy of the most recent report on *ex parte* reexamination filings from the  
18 PTO.

19 6. Well-known intellectual property attorney and law professor, Harold  
20 Wegner, (and incidentally, a partner at Foley & Lardner, attorneys for the parties  
21 filing the 2<sup>nd</sup> reexam), has been reported in the San Diego Intellectual Property  
22 Lawyers Association journal as stating that "today the average *ex parte*  
23 reexamination takes about 5 years (vs. the PTO's claim that it takes 2 years). If an  
24 appeal to the CAFC is involved, that extends the period to 7.7 years."

25 //

26 //

27 //

28 //



## **EXHIBIT A**

**Dennis Crouch's Patently-O**

Friday, June 6, 2008 3:13 AM

**From:** "Patent Law Blog (Patently-O)" <patent@gmail.com>**To:** michael@kalerlaw.com

## Dennis Crouch's Patently-O

**McDonnell Boehnen  
Hulbert & Berghoff LLP**

SPONSOR

**Ex Parte Reexamination**

Posted: 05 Jun 2008 10:05 AM CDT

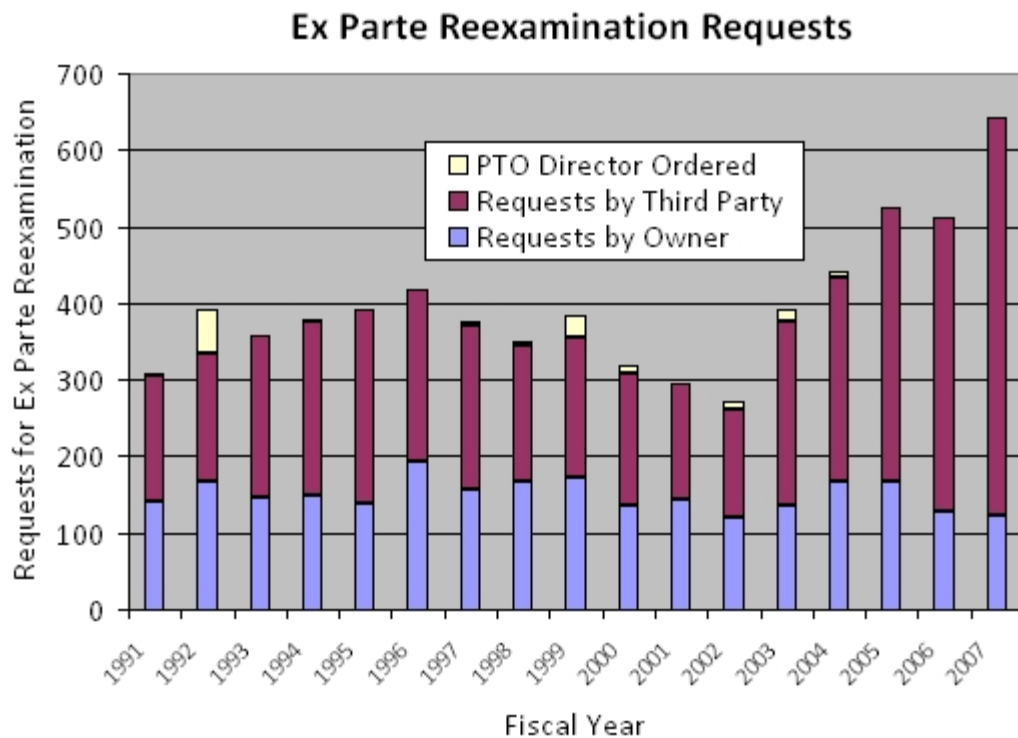
Through its attorneys Microsoft requested *ex parte* reexamination almost thirty Avistar patents. In recent days, the PTO denied Microsoft's request in 14 of those cases.

Standing alone, this denial does not appear to be big news — except for the fact that over 95% of requests for *ex parte* reexamination are granted. In FY 2003–07, for instance, the PTO reviewed 2389 requests for *ex parte* reexamination and only denied the request in 105 cases. (4.4%). (At this point, there is some possibility that the denials are procedural as the documents are not yet available on PAIR).

To be granted, a reexamination request must present a “substantial new question of patentability” that affects at least one claim of a patent. The request must be based on a prior art patent or publication. Prior public use or sale are not admissible as evidence in an *ex parte* reexamination proceeding (although affidavits explaining the prior art publications is admissible).

In general, there has been a rise in requests for *ex parte* reexamination. As the chart below demonstrates, increase is entirely due to an increase in requests for reexamination that are filed by third parties.

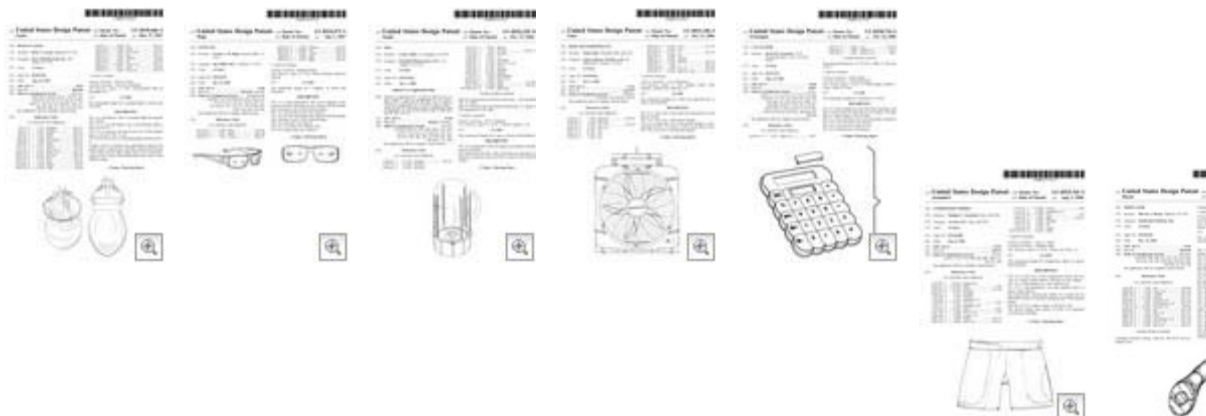




- **Statistics are from the USPTO Annual Report FY 2007** and other annual reports.
- **Avistar News Story**

## Some Design Patents That Have Been Litigated

Posted: 05 Jun 2008 10:31 AM CDT



## **EXHIBIT B**



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

Ex Parte Reexamination Filing Data - March 31, 2008

1. Total requests filed since start of ex parte reexam on 07/01/81 ..... 9225<sup>1</sup>
  - a. By patent owner ..... 3520 38%
  - b. By other member of public ..... 5540 60%
  - c. By order of Commissioner ..... 165 2%
  
2. Number of filings by discipline
  - a. Chemical Operation ..... 2735 30%
  - b. Electrical Operation ..... 3111 34%
  - c. Mechanical Operation ..... 3379 36%
  
3. Annual Ex Parte Reexam Filings
 

Fiscal Yr.	No.	Fiscal Yr.	No.	Fiscal Yr.	No.	Fiscal Yr.	No.
1981	78 (3 mos.)	1989	243	1997	376	2005	520
1982	187	1990	297	1998	350	2006	511
1983	186	1991	307	1999	385	2007	642
1984	189	1992	392	2000	318	2008	330 YTD
1985	230	1993	359	2001	296		
1986	232	1994	379	2002	272		
1987	240	1995	392	2003	392		
1988	268	1996	418	2004	436		
  
4. Number known to be in litigation ..... 2465 27%
  
5. Determinations on requests ..... 8874
  - a. No. granted ..... 8150 ..... 92%
    - (1) By examiner ..... 8037
    - (2) By Director (on petition) ..... 113
  - b. No. denied ..... 724 ..... 8%
    - (1) By examiner ..... 689
    - (2) Order vacated ..... 35

<sup>1</sup>Of the requests received in FY 2008, 28 requests have not yet been accorded a filing date, and preprocessing of 13 requests was terminated for failure to comply with the requirements of 37 CFR 1.510. See Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings, Final Rule, 71 Fed. Reg. 44219 (August 4, 2006).



6. Total examiner denials (includes denials reversed by Director) .....	802		
a. Patent owner requester	440	55%	
b. Third party requester	362	45%	
7. Overall reexamination pendency (Filing date to certificate issue date)			
a. Average pendency	24.1 (mos.)		
b. Median pendency	18.8 (mos.)		
8. Reexam certificate claim analysis:	Owner Requester	3rd Party Requester	Comm'r Initiated
			Overall
a. All claims confirmed	23%	28%	12%
b. All claims cancelled	7%	13%	21%
c. Claims changes	70%	59%	67%
9. Total ex parte reexamination certificates issued (1981 - present) .....	6164		
a. Certificates with all claims confirmed	1575	26%	
b. Certificates with all claims canceled	658	10%	
c. Certificates with claims changes	3931	64%	
10. Reexam claim analysis - requester is patent owner or 3rd party; or Comm'r initiated.			
a. Certificates - PATENT OWNER REQUESTER .....	2632		
(1) All claims confirmed	595	23%	
(2) All claims canceled	198	7%	
(3) Claim changes	1839	70%	
b. Certificates - 3rd PARTY REQUESTER .....	3386		
(1) All claims confirmed	962	28%	
(2) All claims canceled	432	13%	
(3) Claim changes	1992	59%	
c. Certificates - COMM'R INITIATED REEXAM .....	146		
(1) All claims confirmed	18	12%	
(2) All claims canceled	30	21%	
(3) Claim changes	98	67%	